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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/623,681	09/07/2000	David Fisher	540-231	6218

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Nixon & Vanderhye
8th Floor
1100 North Glebe Road
Arlington, VA 22201-4714

EXAMINER

BRYANT, DAVID P

ART UNIT

PAPER NUMBER

3726

DATE MAILED: 12/18/2001 ,

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/623,681

Applicant(s)
FISHER et al.

Examiner
David Bryant

Group Art Unit
3726



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas (U.S. Patent No. 3,609,116).

a. Claim 1 recites the following steps, which are disclosed by Thomas as noted:

providing a sub-structure; in column 7, line 26, reference is made to a lap joint between parts, the bottom one of which may be construed as the claimed "sub-structure"

positioning shim material on part of the sub-structure; in column 7, lines 22-27, a moldable shim material is disclosed which is to be applied between the lap joint

curing the shim material; in column 7, lines 28-29, it is disclosed that the moldable shim material is cured at room temperature

machining the cured shim material to desired thickness; in column 7, lines 35-43, it is disclosed that the shim material may be applied to the sub-structure prior to mating of the parts, and may be machined (inherently to "a desired thickness")

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assembling an outer layer with the sub-structure such that the shim lies between the two; in column 7, line 26, reference is made to the lap joint between parts, 'with the shim material disposed between a bottom part and an upper part—the upper part may be construed as the claimed “outer layer”

b. Claims 2 and 10-12: In column 2, lines 10-14, it is disclosed that the moldable shim material “cures at room temperature (75°F)” and may be positioned “in either horizontal, vertical or overhead positions without excess flow.”

c. Claims 7 and 8: In column 7, lines 36-38, it is disclosed that the shim material may be pressed (i.e. pre-formed) into strips, and then applied in strip form prior to mating of the parts.

d. Claim 9: In column 7, line 27, it is disclosed that the shim material may be applied up to 0.125 inch (3.175 mm) thick, which falls within the claimed range of 0.4 to 4.0 mm.

3. Claims 1, 2, 5, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicant's admitted prior art (AAPA).

AAPA is found in the specification from the last two lines on page 1 through line 7 on page 2, and explicitly teaches each of the claimed steps recited in claims 1, 2, 5, and 6.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (U.S. Patent No. 3,609,116) or AAPA.

Thomas and AAPA teach the invention essentially as claimed, as set forth above.

However, Thomas and AAPA fail to teach curing the shim material by exposure of the shim material to ultra violet light or radio frequency radiation.

The manner in which the shim material is cured is deemed to have been an obvious matter of choice, since applicant has not disclosed that the particular curing process solves any stated problem, and it appears that a simple room temperature cure of the type taught by Thomas or AAPA would provide equivalent results.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner David Bryant whose telephone number is (703) 308-1859. The examiner can be reached Monday-Thursday from 6:30 AM to 5:00 PM.



**DAVID BRYANT
PRIMARY EXAMINER
ART UNIT 3726**

December 17, 2001